

005056.87281  
Appln No.: 09/737,098

MAY 03 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Kanu Patel

Serial No.: 09/737,098

Filed: December 14, 2000

For: AUTOMATED INFORMATION  
ACCESS VIA THE TELEPHONE  
LINE

Atty. Docket No.: 005056.87281

Group Art Unit: 2614

Examiner: Gauthier, Gerald

Confirmation 9085  
No.:**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is responsive to the Final Office Action mailed on January 4, 2006 and the Advisory Office Action mailed March 31, 2006. A notice of appeal and a request for a one month extension of time is filed concurrently with this request for review.

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### Discussion and Argument

The Final Office Action mailed January 1, 2006 rejected independent claims 1, 15 and 27 under 35 U.S.C § 103(a) as being unpatentable over US Patent No. 5,521,966 (Friedes), in view of US Patent No. 6,253,069 (Mankovitz), in view of US Patent No. 6,040,921 (Hayashi), and in further view of US Patent No. 6,728,348 (Denenberg). Independent claim 9 was also rejected under 35 U.S.C § 103(a) as being unpatentable over Friedes in view of Mankovitz in view of Hayashi in view of Denenberg and further in view of US Patent No. 6,446,111 (Lowry). For the purposes of this review, claim 1 is representative of independent claims 15 and 27 and the arguments provided with respect to independent claim 1 also apply, albeit in appropriately modified fashion, to independent claims 15 and 27. Similar arguments also apply to independent claim 9 along with additional arguments discussed below.

Turning to the language of independent claim 1, the portion of claim 1 relevant to the current discussion is provided below:

(1) A system for obtaining credit history information of a person via a telephone network comprising in combination:

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(e) a data search handler that searches the searchable database by matching the digit string that corresponds to an actual name and address of the person.

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The Final Office Action mailed January 1, 2006 suggests that Denenberg discloses (e). As noted in Applicant's Response mailed March 3, 2006, pg. 7-8, however, Denenberg does not actually disclose "a data search handler" as claimed because Denenberg fails to even suggest matching an address of a person. Thus, the rejection under 35 U.S.C. §(a) fails to make a *prima facie* case of obviousness with respect to claim 1 for the reasons discussed in Applicant's Response. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations."). Furthermore, as noted in Applicant's Response mailed March 3, 2006, pg. 8-9, the Final Office Action of January 1, 2006 fails to provide motivation to combine the four references. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. First,

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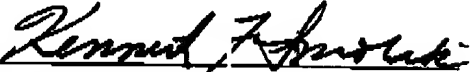
there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."'). In addition, as noted in Applicant's Response mailed March 3, 2006, pg. 8, the Denenberg reference's requirement for additional interaction removes any motivation that might have otherwise existed. These deficiencies exist with respect to all pending claims, therefore, for these reasons alone the rejection of the pending claims should be withdrawn.

In addition, independent claim 9 was rejected in view of a 5-way combination of references as noted above. As noted in Applicant's Response mailed March 3, 2006, pg. 10, no motivation was provided to combine these 5 references. In addition, as noted in Applicant's Response mailed March 3, 2006, pg. 10 the motivation to combine Lowery was necessarily improper because it relied on a reference not used and cannot support a *prima facie* case of obviousness.

In summary, the pending claims 1, 4-9, 12-15, 18-20, and 27-29 include at least one feature not disclosed, suggested or taught by the cited references, alone or in combination. In addition, the motivation to combine the references was not properly supported and was necessarily improper with respect to independent claim 9. Therefore, the rejections of claims 1, 4-9, 12-15, 18-20, and 27-29 under 35 U.S.C § 103(a) as being unpatentable over the references of record should be withdrawn.

Respectfully submitted,

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